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Typed or Printed Name

Steven F. Goldstein

Signature

St F Goldstein

Date

December 13, 2002

**RESPONSE TO
RESTRICTION
REQUIREMENT**

Address to:
Assistant Commissioner for Patents
Washington, D.C. 20231

Attorney Docket

IRVN-007CON

First Named Inventor

Gale A. Granger

Application Number

09/712,813

Filing Date

November 13, 2000

Group Art Unit

1646

Confirmation Number

4642

Examiner Name

Joseph F. Murphy

Title

"Treating Arthritis with TNF Receptor
Releasing Enzyme"#13
Mg
1/2/02

Sir:

This Response to Restriction Requirement is responsive to the Office Action mailed September 16, 2002, which set a one month period for response, making a response due October 16, 2002. A Petition for a two Month Extension of Time is submitted with this Response, making this Response due on or before December 16, 2002. As such, a response is timely filed.

Restriction Requirement

In the Office Action, the Examiner set forth a Restriction Requirement requiring election of one of the following groups of claims:

- Group I: Claims 43-66, drawn to a method for treating an arthritic or inflammatory condition by administration of a protein encoded by SEQ ID NO: 8;
- Group II: Claims 67-69, drawn to a pharmaceutical composition comprising the protein encoded by SEQ ID NO: 8;
- Group III: Claims 67-69, drawn to a pharmaceutical composition comprising the protein encoded by SEQ ID NO: 9; and
- Group IV: Claims 43-66, drawn to a method for treating an arthritic or inflammatory condition by administration of a protein encoded by SEQ ID NO: 9.

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Election of group for examination

Applicants hereby provisionally elect to prosecute the claims of Group IV, claims 43-66 and SEQ. ID NO:9, and traverse the restriction requirement to the extent the Groups are restricted according to the sequence. The grounds for traverse are set out below.

Traverse of restriction requirement

Applicants *traverse* the restriction between Group I and Group IV, and between Group II and Group III. As stated in the MPEP §803, if search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Each of the recited sequences — SEQ ID NOS: 8 and 9 — has already been searched in the examination of priority application USSN 09/081,385. Accordingly, it would not be a burden on the Examiner to consider these sequences together, and no restriction is permitted (MPEP § 804).

Accordingly, applicants request that Group IV be consolidated with Group I, and Group III be consolidated with Group II.

Request for rejoinder

Applicants do not traverse the restriction between Groups I and II, or between Groups III and IV.

However, novelty of the protein encoded by SEQ. ID NOS:8 and 9 has already been established in the priority application. It would not be a burden on the Examiner to consider product claims and method claims together, since novelty of the product confers novelty on its use.

Applicants respectfully request that claims 47-69 all be examined together with respect to both SEQ. ID NO:8 and SEQ. ID NO:9.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815 Order No. IRVN-007CON.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: Dec 13, 2002

By: Carol L. Francis
Carol L. Francis
Registration No. 36,513

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PTO/SB/21 (08-00)
Approved for use through 10/31/2002. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)		Application Number	09/712,813	
		Filing Date	November 13, 2000	
		First Named Inventor	GRANGER, GALE A.	
		Group Art Unit	1646	
		Examiner Name	MURPHY, JOSEPH F.	
Total Number of Pages in This Submission		7	Attorney Docket Number	IRVN-007CON
ENCLOSURES (check all that apply)				
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group		
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences		
<input checked="" type="checkbox"/> Response to Restriction Requirement	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)		
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information		
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter		
<input checked="" type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):		
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Change of Correspondence Address	Return Postcard		
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Terminal Disclaimer			
<input type="checkbox"/> Certified Copy of Priority Documents	<input type="checkbox"/> Request for Refund			
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	<input type="checkbox"/> CD, Number of CD(s) _____			
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	Remarks			
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT				
Firm or Individual Name	CAROL L. FRANCIS, Reg. No. 36,513			
Signature				
Date	December 13, 2002			

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Typed or printed name	Steven F. Goldstein		
Signature		Date	December 13, 2002

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PTO/SB/17 (10-01)

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FEE TRANSMITTAL for FY 2002

Patent fees are subject to annual revision.

Complete if Known

Application Number	09/712,813
Filing Date	November 13, 2000
First Named Inventor	GRANGER, GALE A.
Examiner Name	MURPHY, JOSEPH E.
Group Art Unit	1646
Attorney Docket No.	IRVN-007CON

TOTAL AMOUNT OF PAYMENT

(\$ 200)

METHOD OF PAYMENT

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit overpayments to:
- Deposit Account Number 50-0815
Deposit Account Name Bozicevic, Field & Francis LLP
- ☒ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17
☒ Applicant Claims small entity status. See 37 CFR 1.27

2. ☐ Payment Enclosed:☐ Check ☐ Credit Card ☐ Money Order ☐ Other

FEE CALCULATION

2. BASIC FILING FEE

Large Fee Code	Entity (\$)	Small Fee Code	Entity (\$)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	

SUBTOTAL (1)

1. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid
27-27	= 0 x	=	
Indep. Claims 4-4	= 0 x	=	
Multiple Dependent			

Large Fee Code	Entity (\$)	Small Fee Code	Entity (\$)	Fee Description	Fee Paid
103	18	203	9	Claims in excess of 20	
102	84	202	42	Independent claims in excess of 3	
104	280	204	140	Multiple dependent claim, if not paid	
109	84	209	42	** Reissue independent claims over original patent	
110	18	210	9	** Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) \$ 0

**or number previously paid, if greater; For Reissues, see above.

FEE CALCULATION (continued)

Large Fee Code	Entity (\$)	Small Fee Code	Entity (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for ex parte reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examination action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	200
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1.17(q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	For each additional invention to be examined (37 CFR § 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 200)

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)	Carol L. Francis	Registration No. (Attorney/Agent)	36,513	Telephone	(650) 327-3400
Signature		Date	12/13/2002		

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